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REMARKS

Claims 29-33, 40, and 48-64 are pending in the present application after withdrawn claims 1-28, 34-39, and 41-47 have been canceled. Claims 48-52 remain withdrawn in response to an earlier restriction requirement. Claims 29, 53-55, and 57-59 have been amended. No new matter is added by the amendments, which find support throughout the specification and figures. In particular, the amendment to claim 29 is supported at least in figures 36 and 37 and in the Specification from page 40, line 24 to page 41, line 4. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

Applicants elected species 17 in the Election filed on November 10, 2005, but also argued therein that claims 53 and 59 are generic to species 16 and 17, and that claims 48-52 read on species 16.

Applicants note with appreciation that the Examiner acknowledges that claims 59-64 are allowed, and that claims 32, 33, and 54-58 include allowable subject matter. Claim 32 has been amended into independent form including the limitations of its base claim, and therefore claim 32 is in condition for allowance. Likewise, claim 33, which depends from claim 32, is allowable.

Claim 59 is objected to due to an informality. Claim 59 has been amended as suggested by the Examiner and therefore it is respectfully requested that the objection be withdrawn.

Claims 54 and 55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the specification does not disclose the features of claims 54 and 55. Claims 54 and 55 have been amended to respond to this rejection, and it is respectfully submitted that the amended claims are allowable.

Claims 29, 30, 31, 40, and 53 are rejected under 35 U.S.C. 103(a) as being unparentable over United States Publication No. 2003/0075726 to Ker et al.(hereinafter referred as Ker) in

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combination with United States Patent No. 5,465,189 to Polgreen et al.(hereinafter referred to Polgreen). Applicants respectfully traverse.

Claim 29 relates to an electro-static discharge protection device that includes, *inter alia*, a first conductive type layer or a first conductive type substrate. In amended claim 29, a distance between a first high concentration first conductive type region and a second high concentration second conductive type region is shorter than a further distance between a first high concentration second conductive type region and a second high concentration second conductive type region.

Regarding claim 29, the Examiner asserts that Ker teaches all of the features of claim 29 except the use of two distinct power supplies. The Examiner asserts that Polgreen discloses the use of two power supplies, and relies on Polgreen to provide the motivation to combine the references. In particular, the Examiner asserts that protection from electrostatic discharge stress, as discussed in Polgreen at col. 5, lines 37-38, provides the motivation to combine Polgreen and Ker. However, this conclusory reasoning is insufficient to support a claim of obviousness.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

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The Federal Circuit addressed the standard for obviousness and the requirement of motivation in Teleflex, Inc. et al. v. KSR Int'l Co., (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, ***but some motivation to combine the prior art teachings in the particular manner claimed.***" (*Teleflex*, citing *In re Kozab*; emphasis added). The Federal Circuit found that that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, ***the test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.***

(*Teleflex*, citing as background *Rouffei*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Polgreen to combine its teaching with Ker. Polgreen apparently discusses semiconductor controlled rectifiers. However, there is no motivation in Polgreen to suggest a combination with the SCR device discussed in Ker. As the *Teleflex* court held, there must be ***specific teaching*** to motivate a person of ordinary skill in the

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art must to combine the prior art teachings *in the particular manner claimed*. Therefore, since there is no motivation to combine the references, the rejection is improper.

However, in the interest of expediting prosecution, claim 29 is amended herein to recite the feature that a distance between a first high concentration first conductive type region and a second high concentration second conductive type region is shorter than a further distance between a first high concentration second conductive type region and a second high concentration second conductive type region. In the above amendment, a limitation that the distance between the anode (24) and the cathode (27) of the resistor is shorter than a distance between the trigger current supply area (71) and the cathode (27) is added, as shown in figures 36 and 37. This technical matter is described in the Specification from page 40, line 24 to page 41, line 4. In Ker and Polgreen, a trigger current supply area (elements 117, 308, or 408 in Ker) is provided between the anode and the cathode, and therefore the structure is different from the present invention, as recited in claim 29. Therefore, for at least this additional reason, claim 29 is allowable.

Claims 30, 41, and 40 depend from claim 29 and are allowable for at least the same reasons as claim 29 is allowable.

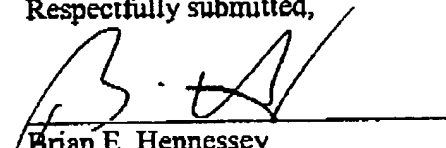
The Office Action indicates that the feature of claim 53 of substantially simultaneous triggering of two bipolar transistors is not given patentable weight. (Office Action; page 5, lines 7-9). Claim 53 has been amended to read "a trigger device adapted to trigger the first and second bipolar transistors substantially simultaneously." Therefore it is respectfully requested that the amended feature modifies the trigger device, and should be afforded patentable weight. It is also respectfully submitted none of the cited references disclose or suggest this feature, and therefore amended claim 53 is allowable.

Serial No.: 10/728,379**CONCLUSION**

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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